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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,792	06/30/2000	Arjun Rajagopalan	020431.0578	2259

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EXAMINER

VIG, NARESH

ART UNIT PAPER NUMBER

3629

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/608,792

Applicant(s)

RAJAGOPALAN, ARJUN

Examiner

Naresh Vig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-15 and 17-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-15 and 17-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This is in reference to response received on 21 January 2004 to the office action mailed on 10 October 2003. There are 27 claims, claims 1 – 6, 8 – 15 and 17 – 29 pending for examination.

Response to Amendment

The amendment filed on 21 January 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Amendment claim automated functionality, request-specific warranty package, associating historical data for generic items with one or more warranty coverage characteristics for generating items which is not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

In response to applicant's argument in the email received on April 16, 2004 that the various steps of the method are performed by one or more computer systems (e.g., at least warranty transaction system 30 and its components), which are capable of performing certain steps of the method substantially without human intervention, in other words, automatically. In the amended claim "automatically generating request-specific warranty packages" is not supported by the specification. Applicant has added

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new matter "automatically generating request-specific warranty package" which is neither supported, inherently included nor obvious in the application. To expedite this application, it is recommended that a continuation in part be filed to include this new limitation.

Note: Applicant is requested to add the statement "No new matter has been added" to the next response.

Response to Arguments

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, WarrantyDirect discloses providing users access to system and method for getting extended warranty (product) over the internet, whereas, LendingTree discloses providing users access to system and method for getting loans (product) over the internet, and, HomeGain discloses providing users access to system and method for getting real estate agent's

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services (product) over the internet. All these references disclose system and method of marketing products over the internet.

In response to applicant's cited references do not teach receiving warranty request from customer computer. However, WarrantyDirect allows customers to request for quote by providing a form (customer makes request from customer computer), which the customer uses to provide the information about the product they are requesting the price quote for warranty [page 5], where customer specifies a particular item (Year, make, model) [page 5].

WarrantyDirect does not disclose identification of particular item. Official notice is taken that businesses have used Vehicle Identification Numbers (VIN), Serial numbers (VIN are serial numbers of automobiles) are used to identify a particular item brought in for under warranty repairs.

In response to applicant's argument that cited references do not teach automatically accessing historical data. However, automation is new matter which is not supported by the applicant's disclosure.

In response to applicant's argument cited references do not teach generating plurality of request-specific warranty packages. However, "request specific warranty packages" is new matter which is not supported by the applicant's disclosure.

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In response to applicant's argument the cited references do not teach "one or more rules". Applicant claims "one or more rules each associating historical data for generic items with one or more warranty coverage characteristics". However, "historical data for generic items" is new matter which is not supported by the applicant's disclosure.

In response to applicant's argument that cited references do not teach "receiving customer selection". However, WarrantyDirect discloses capability of receiving customer selections [page 18].

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 – 6, 8 – 15 and 17 – 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example:

Claims 1, 11, 20 and 29 claim automated functionality which is not described in the specification.

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Claims 1, 11, 20 and 29 recites "request-specific warranty package" which is not described in the specification.

Claims 1, 11, 20 and 29 recites "associating historical data for generic items with one or more warranty coverage characteristics for generating items" which is not described in the specification.

Claims 2 – 6 and 8 – 10 are rejected because they claim subject matter of claim 1.

Claims 11 – 15 and 17 – 19 are rejected because they claim subject matter of claim 11.

Claims 21 – 28 are rejected because they claim subject matter of claim 20.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 6, 8 – 15 and 17 – 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warranty Direct hereinafter known as WarrantyDirect in view of Lending Tree, Inc. hereinafter known as Lendingtree and further in view of HomeGain.Com hereinafter known as HomeGain.

Regarding claims 1, 11, 20 and 29, WarrantyDirect discloses system and method to sell extended warranty to their customers. WarrantyDirect allows customers to request for quote by providing a form, which the customer uses to provide the information about the product they are requesting the price quote for warranty [page 5].

WarrantyDirect discloses provide plurality of warranty packages and information about the type of coverage in each package [page 17]. Customers get the warranty coverage based upon the coverage level they have selected.

WarrantyDirect discloses Warranty Direct's Automated Quote system for generating the quote based upon the information provided by the customer. Customer is given a choice to elect what level warranty coverage they would like to get the quotation for [page 5].

WarrantyDirect discloses that customers can purchase Warranty protection online, or, by contacting WarrantyDirect via telephone or fax.

WarrantyDirect does not disclose identification of particular item. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that business use unique identifiers to identify products. It is a business choice to elect what information to use for identification. A business may elect their own generated number (e.g. applying a sticker with unique number on the vehicle) Serial Numbers (S/N), Vehicle Identification Numbers (VIN), registration tag numbers, owners name with vehicle make and model, customers telephone number to identify the product when it is brought in for service. Therefore, it would have been obvious to one

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of ordinary skill in the art at the time the invention was made that WarrantyDirect uses some sort of identification to ensure that customer gets the repair services and the repair service provider gets compensated for the repair performed.

WarrantyDirect does not disclose communicating warranty package to one or more warranty service providers. However, WarrantyDirect discloses that at the time when repair services are required, repair service professional contacts WarrantyDirect for payment [page 11]. LendingTree disclose system and method which allows customers to provide information for the loan service they require, and, LendingTree discloses that after the customer has provided information, within two business days, customers can receive response from various lenders (mortgage service providers). In addition, HomeGain discloses system and method which allows user to request bids from plurality of service estate agents (service providers) to sell the property. After completing the basic sign-up process, customer is logged into the control center. Customer can create a seller profile. Completed seller profile (requirements) are sent to real estate agents (service providers) for their review [page 20]. Therefore, it would have been obvious to a person with ordinary skill in the art to communicate requirements to one or more providers to provide information to their service providers and receive the competitive bids for their users. Therefore, it is known at the time of invention to a person with ordinary skill in the art that quote for service can be provided by a single source (service provider owns the system), or, the quote can be provided by plurality of service providers (business owning the system acts as a middle man, e.g.

LendingTree) to have the affiliates pay for keeping the system running, and, providing competing prices to customers.

WarrantyDirect does not disclose accessing information from other sources for the particular item (item that the customer wants to get the services for). HomeGain discloses that its property value estimates are generated through various sources of data [page 19]. CarFax discloses that customers can get information on a particular vehicle (identified by VIN) from CarFax (other source) to get information on a vehicle which may not be readily available to the customer [page 10, 12, 13]. CarFax discloses to gather information from numerous sources to provide comprehensive vehicle history information (product offered by CarFax) [page 3]. CarFax discloses other businesses use CarFax services to make better business decisions [page 22]. Also, CarFax disclose providing link to WarrantyDirect [page 46]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that business can access information from other sources to get the current information for making better business decision. For example, used car dealership can use CarFax information to determine the price to purchase the car from a seller, HomeGain clients can use the home valuation to determine whether they would want to sell their home etc., real estate agents access information from Multiple Listings to get information on Home Values to determine the commissions they would charge the seller for rendering their services.

WarrantyDirect discloses one or more warranty packages for a particular item (vehicle) [page 17]. Also, HomeGain discloses that sellers may receive proposals from plurality of agents for rendering their services [page 4].

WarrantyDirect discloses communicating warranty packages for the particular item to the customer [page 5].

WarrantyDirect discloses receiving selection warranty package from customer. Also, HomeGain discloses receiving selection from customer [page 18].

WarrantyDirecet discloses communicating customer selection to service provider (itself). HomeGain discloses communicating customer selection to service providers (agents) [page 18].

Regarding claims 2, 12, and 21, WarrantyDirect discloses Warranty Direct's Automated Quote system for generating the quote based upon the information provided by the customer. Customer is given a choice to elect what level warranty coverage they would like to get the quotation for [page 5]. WarrantyDirect discloses provide plurality of warranty packages and information about the type of coverage in each package [page 17]. Customers get the warranty coverage based upon the coverage level they have selected.

Regarding claims 3 – 4, 13 – 14 and 22 – 23, WarrantyDirect discloses provide plurality of warranty packages and information about the type of coverage in each package [page 17]. Customers get the warranty coverage based upon the coverage

level they have selected. WarrantyDirect discloses Warranty Direct's Automated Quote system for generating the quote based upon the information provided by the customer. It is obvious that WarrantyDirect stores information from customers to be able to provide the requested information.

Regarding claims 5 – 6, 15 and 24 – 25, WarrantyDirect discloses to be communicating warranty packages over the internet. It is obvious that a user will use a browser to access the information over the internet.

WarrantyDirect does not disclose communicating warranty package to one or more warranty service providers. However, WarrantyDirect discloses that at the time when repair services are required, repair service professional contacts WarrantyDirect for payment [page 11]. LendingTree disclose system and method which allows customers to provide information for the loan service they require, and, LendingTree discloses that after the customer has provided information, within two business days, customers can receive response from various lenders (mortgage service providers). In addition, HomeGain discloses system and method which allows user to request bids from plurality of service estate agents (service providers) to sell the property. After completing the basic sign-up process, customer is logged into the control center. Customer can create a seller profile. Completed seller profile (requirements) are sent to real estate agents (service providers) for their review [page 20]. Therefore, it would have been obvious to a person with ordinary skill in the art to communicate requirements to one or more providers to provide information to their service providers

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and receive the competitive bids for their users. Therefore, it is known at the time of invention to a person with ordinary skill in the art that quote for service can be provided by a single source (service provider owns the system), or, the quote can be provided by plurality of service providers (business owning the system acts as a middle man, e.g. LendingTree) to have the affiliates pay for keeping the system running, and, providing competing prices to customers.

Regarding claims 8, 17 and 26, WarrantyDirect does not disclose identification of particular item. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that unique identifiers like Serial Numbers (S/N), Vehicle Identification Numbers (VIN) are used for identification purposes to ensure that the product brought in for service is the actual product for which the customer purchase the warranty service. During the registration of a vehicle, the Motor Vehicle Authority at the jurisdiction requires the VIN to identify the vehicle for which the number plates (tags) are issued. Also, during a traffic violation, law enforcement officer checks the VIN of the vehicle to identify whether the tags on the vehicle belong to that vehicle. CarFax discloses using VIN to find vehicle history. Therefore, it would have been obvious to a person with ordinary skill in the art to use VIN of the vehicle to identify the vehicle, its make, model, year of manufacture etc. to determine whether the vehicle is a lemon, salvage vehicle, rental vehicle, prevent the customer from filing a claim for a similar vehicle. For example, vehicle tag number as a

means for identification may not work because tag numbers can be transferred to another vehicle when a person replaces a car (done in the State of Maryland).

Regarding claims 9 – 10, 18 – 19 and 27 – 28, WarrantyDirect does not disclose generating bids, and communicating bids. However, LearningTree discloses that within two business days after the customer has provided the information, plurality of lender will respond – all competing for customers business [page 2]. In addition, HomeGain allows user to request bids from plurality of service estate agents (service providers) to sell customer's property. After completing the basic sign-up process, customer is logged into the control center. Customer can create a seller profile. Completed seller profile (requirements) are sent to real estate agents (service providers) for their review. Service Providers can view all the information available about available listings. Service Providers can 'Submit A Proposal' (bid) to the seller. When an agent responds to seller profile with a service proposal, the proposal is stored in Seller Control Center and the customer is notified immediately. Customers can review proposals. Customers can contact an agent by clicking of the envelope icon next to the proposal. It is a business choice on how a business elects to close a deal. HomeGain elected customers contact the agent and discuss further to help them make decision on which agent is qualified to sell their home [pages 20 – 27]. In addition, LendingTree discloses customers getting bids from the lenders, and, when a customer accepts a loan offer from a lender, LendingTree asks customers to send response through LendingTree. Therefore, it would have been obvious to a person with ordinary skill in the art to get bids from

suppliers to save money for their customers by providing competitive bids from their service providers.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

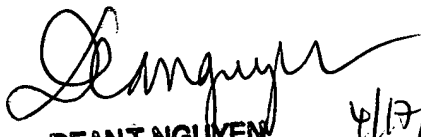
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Naresh Vig
April 16, 2004


DEANT. NGUYEN
PRIMARY EXAMINER 4/17/04